

REMARKS

Claims 2-4 have been amended to conform to the amended claim language of claim 1 and not in response to any claim rejection. The amended claims 2-4 do not include any limitation that is not present in the originally filed claims 2-4.

Claim 9 has been rewritten in independent form and is essentially the same claim as the originally filed claim 9.

The Examiner rejected claims 1 and 5-8 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe et al. (Hereinafter Pepe), US 5,673,322, in view of Gauvin et al. (Hereinafter Gauvin), US 5,790,800.

The Examiner rejected claim 2 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin as applied to claim 1 above, and further in view of Wils et al. (Hereinafter Wils), US 6,570,881.

The Examiner rejected claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claim 1, and further in view of Backstrom et al. (Hereinafter Bakstrom), US 5,903,851.

The Examiner rejected claim 4 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claim 1, and further in view of van Landegem et al. (Hereinafter Landegem), US 5,265,091.

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claim 8, and further in view of O'Connell et al. (Hereinafter O'Connell), US 6,661,787.

Applicants respectfully traverse the §103(a) rejections with the following arguments.

35 U.S.C. §103(a)Claims 1 and 5-8

The Examiner rejected claims 1 and 5-8 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe et al. (Hereinafter Pepe), US 5,673,322, in view of Gauvin et al. (Hereinafter Gauvin), US 5,790,800.

Applicants respectfully contend that claim 1 is not unpatentable over Pepe in view of Gauvin, because Pepe in view of Gauvin does not teach or suggest each and every feature of claim 1. For example, Pepe in view of Gauvin does not teach or suggest the feature: "compensating a disadvantageous characteristic of the first protocol, said compensating comprising ascertaining that a condition exists and eliminating the condition in response to said ascertaining, said condition being a connection condition or a transmission capacity condition".

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Pepe in view of Gauvin, and that claim 1 is in condition for allowance. Since claims 5-8 depend from claim 1, Applicants contend that claims 5-8 are likewise in condition for allowance.

Claim 2

The Examiner rejected claim 2 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin as applied to claim 1, and further in view of Wils et al. (Hereinafter Wils), US 6,570,881.

Since claim 2 depends from claim 1, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin under 35 U.S.C. §103(a), Applicants maintain that

claim 2 is likewise not unpatentable over Pepe in view of Gauvin and further in view of Wils under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of Wils does not teach or suggest the feature: "wherein the ascertaining comprises determining loss of a connection, and wherein the eliminating comprises re-establishing the connection."

The Examiner argues: "As per claim 2, Pepe and Gauvin taught the invention substantially as claimed in claim 1. Pepe and Gauvin did not specifically teach wherein the act of compensating further comprises the acts of determining loss of a connection and reestablishing the connection responsive to the act of determining loss. Wils taught a network status determining method that detects loss of connection and reestablish of the connection responsive to the act of determining loss (col.6, lines 36-46, col.7, lines 56-67, col.8, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pepe, Gauvin and Wils because Wils' teaching of determining connection loss enables Pepe and Gauvin's method to monitor more specifically and compensate more detail on the protocol, both advantageous or disadvantageous."

In response, Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Pepe by the alleged teaching of Wils in relation to claim 2. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art

to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**"). The Examiner has not made any showing of where the prior art suggests determining loss of a connection and re-establishing the connection "to monitor more specifically and compensate more detail on the protocol, both advantageous or disadvantageous". Thus, the Examiner has provided a reason for the combination by the Examiner's speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for modifying Pepe by the alleged teaching of Wils, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 2.

Claim 3

The Examiner rejected claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claim 1, and further in view of Backstrom et al. (Hereinafter Bakstrom), US 5,903,851.

Since claim 3 depends from claim 1, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin under 35 U.S.C. §103(a), Applicants maintain that claim 3 is likewise not unpatentable over Pepe in view of Gauvin and further in view of Backstrom under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of Backstrom does not teach or suggest the feature: "wherein the ascertaining comprises detecting that a connection is idle, and wherein the eliminating comprises dropping the connection, and re-establishing the connection when a new communication request is intercepted."

The Examiner argues: "As per claim 3, Pepe and Gauvin taught the invention substantially as claimed in claim 1. Gauvin further taught to establish communication when request is intercepted (col.2, lines 38-42, col.12, lines 57-63). Pepe and Gauvin did not specifically teach wherein the act of compensating further comprises the acts of detecting that a connection is idle, dropping the connection, and reestablishing the connection. Backstrom taught to detect idle condition, drop connection and to reestablish connection (abstract, col.3, lines 65-67, col.4, line 1, lines 32-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pepe, Gauvin and Backstrom because Backstrom's teaching of determining idle period enables Pepe and Gauvin's method to monitor more specifically and compensate more detail on the protocol, both advantageous or disadvantageous."

In response, Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Pepe by the alleged teaching of Backstrom in relation to claim 3. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner

has not made any showing of where the prior art suggests determining loss of a connection and re-establishing the connection "to monitor more specifically and compensate more detail on the protocol, both advantageous or disadvantageous". Thus, the Examiner has provided a reason for the combination by the Examiner's speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for modifying Pepe by the alleged teaching of Backstrom, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 3.

Claim 4

The Examiner rejected claim 4 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claim 1, and further in view of van Landegem et al. (Hereinafter Landegem), US 5,265,091.

Since claim 4 depends from claim 1, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin under 35 U.S.C. §103(a), Applicants maintain that claim 4 is likewise not unpatentable over Pepe in view of Gauvin and further in view of Landegem under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of Landegem does not teach or suggest the feature: "wherein the ascertaining comprises determining that transmission capacity is insufficient to process the data communication request within a predetermined interval of time, and wherein the eliminating comprises establishing a parallel connection to increase transmission capacity."

The Examiner argues: "As per claim 4, Pepe and Gauvin taught the invention substantially as claimed in claim 1. Pepe further taught wherein the act of compensating further

comprises the acts of determining that transmission capacity is insufficient process the data communication request (col.9, lines 26-32). Pepe and Gauvin did not specifically teach wherein the act of compensating further comprises the acts of determining the transmission capacity to process the data communication request within a predetermined interval of time, and establishing a parallel connection to increase transmission capacity. van Landegem taught to determine the transmission capacity with a predetermined interval of time and to establish a parallel connection to increase transmission capacity (col.12, lines 15-40, 52-63, col. 14, lines 54-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Pepe, Gauvin and van Landegem because van Landegem's teaching of determining transmission capacity and establishing parallel connection helps Pepe and Gauvin's method to determine bandwidth availability in a periodic basis in a connectionless environment (c.g., first protocol, col.2, lines 14-19)".

In response, Applicants respectfully contend that the Examiner's allegation that "Pepe further taught wherein the act of compensating further comprises the acts of determining that transmission capacity is insufficient process the data communication request (col.9, lines 26-32)" is incorrect. Applicants maintain that col. 9, lines 26-32 of Pepe does not teach "determining that transmission capacity is insufficient process the data communication request". Rather, col. 9, lines 26-32 of Pepe teaches "examining the response to a user's data request and stopping unduly large data objects, for example, from overwhelming the user's system".

In further response, Applicants respectfully contend that Landegem (col.12, lines 15-40, 52-63, col. 14, lines 54-61) does not teach or suggest "determining the transmission capacity to process the data communication request within a predetermined interval of time". To the contrary, Landegem does not place a time limitation on performing said determining the

transmission capacity to process the data communication request.

In yet further response, Applicants respectfully contend that the Examiner has not supplied a persuasive argument as to why a person of ordinary skill in the art would modify Pepe by the alleged teaching of Landegem in relation to claim 4. In particular, the Examiner's has incorrectly asserted that the preceding suggestion or motivation is found in van Landegem, col. 2, lines 14-19, since Landegem, col. 2, lines 14-19 most certainly does not suggest "to determine bandwidth availability in a periodic basis in a connectionless environment" (emphasis added) inasmuch as van Landegem, col. 2, lines 14-19 is totally silent as to said "periodic basis". Thus, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 4.

Claim 9

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claim 8, and further in view of O'Connell et al. (Hereinafter O'Connell), US 6,661,787.

Since claim depends from claim 1, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin under 35 U.S.C. §103(a), Applicants maintain that claim 9 is likewise not unpatentable over Pepe in view of Gauvin and further in view of O'Connell under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of O'Connell does not teach or suggest the feature: "receiving, by the client interceptor, an identification of the server application". The Examiner alleges that Gauvin teaches the preceding feature of claim 9 in col. 9, line 61 - col. 10, line 19, which is incorrect. In fact, Gauvin teaches in col. 10, lines 15-16

that "[t]he logical addresses associated with the connection, e.g., port and server identifications, are provided in step 820". Gauvin does not disclose that said logical addresses are received by the client interceptor as required by claim 9. Rather, Gauvin appears to disclose in col. 9, line 61 - col. 10, line 19 that the logical addresses are provided to the communication manager 200.

Additionally, Pepe in view of Gauvin and further in view of O'Connell does not teach or suggest the feature: "forwarding the identification to an address-resolution server for first-protocol address resolution". Although the Examiner has cited O'Connell, col. 2, lines 1-6 for disclosure of "a table known as an ARP (address resolution protocol) cache", Applicants maintain that O'Connell does not teach or suggest the address-resolution server of claim 9.

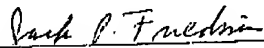
In addition, Applicants respectfully maintain that the Examiner's argument with respect to O'Connell is an improper modification of the secondary reference of Gauvin. The Examiner argues that the primary reference of Pepe discloses most of the features of claim 9. The Examiner also argues that the secondary reference of Gauvin has modified the primary reference of Pepe, by alleging that Gauvin teaches or suggests "receiving ... an **identification** of the server application" (emphasis added). The Examiner additionally argues that the secondary reference of O'Connell has modified the secondary reference of Gauvin, by alleging that O'Connell teaches or suggests "forwarding the **identification** to an address-resolution server ..." (emphasis added). Applicants maintain that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Applicants respectfully maintain that the rejection of claim 9 under 35 U.S.C. §103(a) is

improper and should be withdrawn.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

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